REMARKS

This response is submitted in answer to the Office Action mailed on May 13, 2008.

Claims 148 - 199 are pending. Claims 169 and 170 are allowable if re-written, which is done herein. All other claims are rejected.

RESPONSE TO WITHDRAWAL OF ALLOWABILITY

The Office Action, page 2, states that the previous allowance of claims 148 - 199 is withdrawn, based on "newly discovered references."

Point 1

Applicant points out that MPEP § 706.04 states:

> A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of **all the facts** and approval of the proposed action.
>
> Great care should be exercised in authorizing such a rejection.

Applicant submits that nothing in the Office Action indicates compliance with this MPEP section.

-- There is no evidence presented indicating

that a primary examiner has considered "all

27·

the facts."

--   There is no evidence indicating that "great care" has been exercised.

Point 2

This MPEP section states that the allowance should stand, unless there is

--   "clear error" in the previous action

or

--   knowledge of other prior art.

However, no evidence of "clear error" has been presented by the PTO.

As to "other prior art," it is true that new prior art is now being applied. However, the MPEP's reference to "other prior art" clearly refers to **relevant** prior art.

The new prior art which has been applied is not relevant. As explained herein, for every claim, numerous claim recitations are missing from the new prior art, even taken collectively.

Therefore, Applicant requests that this MPEP section be strictly followed.

RESPONSE TO REJECTION OF CLAIMS 148, 149, 152, 153, 162, 163, 165, 178, AND 179

These claims were rejected as obvious, based on Glowny and

Gill.

Claim 148

Claim 148 recites:

148.   A method of operating a server system and associated Automated Teller Machines, ATMs, comprising:

a)   using the server system to deliver, to a monitor intelligent agent, Monitor Agent,

i)   a list of ATMs, and

ii)   a diagnostic computer program;

b)   causing the Monitor Agent to visit the ATMs on the list in sequence and, at each ATM;

i)   deliver the diagnostic computer program to the ATM;

ii)   receive and store results of the diagnostic computer program after the ATM runs the program; and

iii)   return to the server.

Initial Remark

The Office Action, page 2, section 3, sets forth a collection of operations supposedly found in Glowny.   However, those operations do not correspond to the claims in question.

Further, as explained by the Points below, several claimed operations have not been shown on the Office Action's collection of operations, nor in the other reference, Gill.

Further still the operation of Glowny is **directly opposite** to that claimed, as explained in Point 9, below.

Therefore, the rejections cannot stand.

Point 1

Claim 148 states that a "Monitor Agent" **"visit[s]** the ATMs on the **list** in sequence." No visitation, nor such visitation by a "monitor agent" has been shown in the references. No "list" has been shown in the references.

Further, since no "list" has been shown in the references, the claimed visitation "in sequence" is necessarily absent from the references.

Point 2

. Applicant first points out that claim 148(a) states that a "diagnostic" "program" is delivered to the "Monitor Agent." Thus, the "Monitor Agent" is in possession of that "diagnostic" "program."

Claim 148(b) states that, "at each ATM," the "Monitor Agent" delivers a "diagnostic" "program" to the ATM.

No such delivery of a "diagnostic" "program" to the ATM has been shown in the references.

Point 3

Claim 148 further states that the ATM runs the "diagnostic" "program," and that the "Monitor Agent" stores the results.

That has not been shown in the references.

Point 4

Claim 148 further states that the "Monitor Agent" "return[s] to the server." Since the "Monitor Agent" stores the results, it thus returns the results to the server.

· None of this has been shown in the references.

Point 5

MPEP § 2143.03 states:

> To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

The Office Action has failed to show at least four claim recitations, as required by this MPEP section.

Point 6

The Office Action asserts that it is obvious to substitute the ATM of Gill for Glowny's workstations. Thus, the Office Action is undertaking a substitution-of-equivalents.

MPEP § 2144.06 states:

31

In·order to rely on equivalence as a rationale
supporting an obviousness rejection, the
equivalency must be recognized in the prior
art,

and

cannot be based on applicant's disclosure or
the mere fact that the components at issue are
functional or mechanical equivalents.

The Office Action has not shown that Gill's workstation is
equivalent to an ATM, as required. Further, the non-equivalence
is apparent on the face of the matter. A workstation does not
dispense cash, as does an ATM.

Point 7

The rationale given for combining the references is not valid
under the law of obviousness.

The rationale, in essence, states that, if you substitute
Gill's ATMs into Glowny, then you obtain Glowny's features, but
applied to Gill's ATMs.

Stated more simply, the rationale states that, if you combine
A with B, you obtain the features of A and B together.

That is not a teaching for combining the two references.
MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . After indicating that the rejection is

workstation" contains a diagnostic program. A "local workstation" sends an "execute command" to the "remote workstation," to run the program. The program generates a report, which is sent from the "remote workstation" to the "local workstation."

Under claim 148, multiple ATMs are present, and a server sends an intelligent agent to the ATMs. The intelligent agent carries a diagnostic program, and runs it on ATMs. The intelligent agent gets a report, and carries it to the server.

The multiple ATMs of claim 148 must be analogous to the (multiple) local workstations in Glowny. But the ATMs do not cause the claimed server to run a diagnostic program, as do the local workstations in Glowny, which cause the remote workstation to run a diagnostic.

Further, under the claim, the intelligent agent gets the results, and carries them to the server. In Glowny, the remote workstation sends the results to a local workstation.

. Thus, Glowny is opposite to the claim in at least two respects.

Point 10

This discussion applies to the other claims in this group.

under 35 U.S.C. 103, the examiner should set
forth in the Office action:

. . .

(D) an explanation why one of ordinary skill
in the art at the time the invention was made
would have been motivated to make the proposed
modification.

To establish a prima facie case of
obviousness, three basic criteria must be met.

First, there must be some suggestion or
motivation, either in the references
themselves or in the knowledge generally
available to one of ordinary skill in the art,
to modify the reference or to combine
reference teachings.

Second, there must be a reasonable expectation
of success.

Finally, the prior art reference (or
references when combined) must teach or
suggest all the claim limitations.

**The teaching or suggestion to make the claimed
combination and the reasonable expectation of
success must both be found in the prior art
and not based on applicant's disclosure.**

Point 8

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C.

§ 132, that the PTO specifically identify, in the references, the

claim elements discussed in Points 1 - 4 above.

Point 9

Glowny describes multiple "local workstations." A "remote

33

RESPONSE TO REJECTION OF CLAIMS 150, 151, 154 - 156, 164, AND 166 - 168

These claims were rejected as obvious, based on Glowny, Gill, and Slotznick.

Claim 150

Claim 150 recites:

>   150.   A method of operating a server system and associated Automated Teller Machines, ATMs, comprising:
>
> a) using the server system to deliver, to a monitor intelligent agent, Monitor Agent,
>
>>   i) a list of ATMs, and
>>   ii) a diagnostic computer program;
>
> b) causing the Monitor Agent to visit the ATMs on the list in sequence and, at each ATM;
>
>>   i) deliver the diagnostic computer program to the ATM;
>>   ii) receive and store results of the diagnostic computer program after the ATM runs the program; and
>>   iii) return to the server,
>
> wherein the Monitor Agent comprises a data packet having a format which includes
>>   1) sender's network address,
>>   2) addresses of the ATMs to be visited,
>>   3) the diagnostic program, and
>>   4) a register to contain data obtained from the ATM;
>
> c) using the server to deliver, to a service intelligent agent, Service Agent,
>
>>   i) a list of ATMs,
>>   ii) names of human service technicians,

and
iii)   technical abilities of the service
technicians; and

d)   causing the Service Agent to visit the ATMs on the
list in sequence and, at each ATM, deliver;

i)   the   names   of   the   human   service
technicians, and
ii)   the technical abilities of the service
technicians.

Initial Remark

The Office Action, page 5, section 4, sets forth a collection
of operations supposedly found in Glowny.   However, those
operations do not correspond to the claims in question.

Further, as explained by the Points below, several claimed
operations have not been shown on the Office Action's collection
of operations, nor in the other reference, Gill.

Therefore, the rejections cannot stand.

Point 1

Claim 150 states that a "Monitor Agent" "**visit[s]** the ATMs on
the **list** in sequence."   No visitation, nor such visitation by a
"monitor agent" has been shown in the references.   No "list" has
been shown in the references.

Further, since no "list" has been shown in the references,
the claimed visitation "in sequence" is necessarily absent from
the references.

Point 2

Applicant first points out that claim 150(a) states that a "diagnostic" "program" is delivered to the "Monitor Agent." Thus, the "Monitor Agent" is in possession of that "diagnostic" "program."

Claim 150(b) states that, "at each ATM," the "Monitor Agent" delivers a "diagnostic" "program" to the ATM.

No such delivery of a "diagnostic" "program" to the ATM has been shown in the references.

Point 3

· Claim 150 further states that the ATM runs the "diagnostic" "program," and that the "Monitor Agent" stores the results.

That has not been shown in the references.

Point 4

Claim 150 further states that the "Monitor Agent" "return[s] to the server." Since the "Monitor Agent" stores the results, it thus returns the results to the server.

None of this has been shown in the references.

Point 5

MPEP § 2143.03 states:

37

> To establish <u>prima facie</u> obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

The Office Action has failed to show at least four claim recitations, as required by this MPEP section.

Point 6

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify, in the references, the claim elements discussed in Points 1 - 4 above.

Point 7

This discussion applies to the other claims in this group.

RESPONSE TO REJECTION OF CLAIMS 157 - 161 and 171 - 177

These claims were rejected as obvious, based on Gill and Slotznick.

The Office Action has merely set forth supposed characterizations of the two references. On the face of it, those characterizations fail to show the invention, as claimed. For example, claim 157 states:

> 157. A method of operating a server system and associated Automated Teller Machines, ATMs, comprising:

a) sending a first type of intelligent agent from a server to a group of ATMs, which agent obtains diagnostic information from the ATMs;

b) sending a second type of intelligent agent from a server to a group of ATMs, which agent informs the ATMs of the identities of available service technicians; and

c) sending a third type of intelligent agent from a malfunctioning ATM to a service technician,

wherein all intelligent agents share a common data format.

Point 1

The claim recites **three types** of "intelligent agent." The Office Action's characterizations of the references, at best, shows a **single** intelligent agent, if that.

Point 2

Under the claim,

-- one intelligent agent diagnoses problems in ATMs,

-- a second intelligent agent tells the ATMs who can fix the problems, and

-- a third intelligent agent tells service technicians about the problems.

None of that has been shown in the references.

Point 3

The claim states that "all intelligent agents share a common data format." The Office Action's characterizations fail to show that.

This discussion applies to the other claims in this group.

RESPONSE TO REJECTION OF CLAIMS 180 - 183

These claims were rejected as obvious, based on Gill and Hirosawa.

Claim 181

Claim 181, and its parent claim, state that a "service person A" is notified of a fault. If "service person A" does not respond, then "service person B" is notified.

The Office Action has not shown that in the references.

No Teaching Given

No valid teaching has been given for combining the references. This is discussed in the section at the end of this Amendment.

RESPONSE TO REJECTION OF CLAIMS 184 - 186

These claims were rejected as obvious, based on Gill, Slotznick, Hirosawa, and Glowny.

Claim 184

Claim 184 states:

> d) when an Intelligent agent arrives at an ATM,
>
> > i) verifying security of the intelligent agent and
> >
> > ii) if security is verified, allowing the intelligent agent to perform operations in the ATM.

Point 1

The Office Action cites Glowny as showing this, by stating

> Glowny teaches verifying accuracy and integrity of diagnostic routine.

However, that does not show the claim. The claim states that the "security of the intelligent agent" is verified. Glowny's diagnostic routine is not an "intelligent agent."

Further, under the claim, if the "agent" is verified, it is allowed "to perform operations in the ATM." That has not been shown in Glowny.

Further still, the "agent" in the claim was "sent" to an ATM. That has not been shown in the diagnostic routine in Glowny.

Point 2

Glowny does not actually show "verifying accuracy and

41

integrity of a diagnostic routine," as the Office Action asserts.

Glowny, column 6, lines 1 - 16, is cited to show this. However, that passage merely lists some prior art "canned" computer programs which can be used to write the diagnostic routine needed by Glowny.

That does not show the claimed "verifying security of the intelligent agent," nor the rest of the claim. There is no "intelligent agent" present here in Glowny. Nor is there verification of that (absent) agent.

Claims 185 and 186

The preceding applies to these claims.

RESPONSE TO REJECTION OF CLAIM 187

Claim 187 was rejected as obvious, based on Gill, Hirosawa, and Slotznick.

Claim 187 is seen as patentable, based on its parent claim 180.

RESPONSE TO REJECTION OF CLAIMS 188 AND 199

. These claims were rejected as obvious, based on Gill and Johnstone.

Point 1

Applicant points out that no valid teaching has been given for combining the references. The rationale is based on a goal of "facilitating preventative maintenance" etc. However, Johnstone, **by himself**, attains that goal. There is no reason to add Gill to Johnstone to attain that goal.

Thus, pursuit of the goal, as a matter of logic, does not lead to the combination of the references.

Point 2

It will be assumed <u>arguendo</u> that Gill shows claim 188(a).

The Office Action relies on Johnstone to show claim 188(b). However, claim 188(b) states "based on **THE INFORMATION**, making predictions." Johnstone makes no "predictions" based on fault conditions in Gill.

· That is, there is no connection between the reported fault conditions in Gill and the "predictions" in Johnstone.

Therefore, claim 188(b) has not been shown in the references.

Point 3

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

43

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As explained in Point 2, above, Johnstone makes no predictions based on anything in Gill. Therefore, there is no connection between predictions made in Johnstone, and the "information" obtained by Gill in claim 188(a).

No expectation of success has been shown.

Specifically, claim 188(c) states that "maintenance personnel" are "scheduled" to perform "procedures." Necessarily, those "procedures" apply to the claimed ATM. Johnstone performs no "procedures" on an ATM.

Further, Johnstone takes remedial action when a machine tool appears to be wearing out. The "information" in Gill has no relevance to machine tools. Johnstone cannot take any action based on it.

Point 4

Claim 199 recites computing a "time." That has not been shown in either reference.

RESPONSE TO REJECTION OF CLAIM 189

This claim was rejected as obvious, based on Gill, Johnstone, and Glowny

Point 1

The Office Action asserts that Glowny verifies security of the intelligent agent, as claimed. As explained above, in connection with claim 184, that is not so.

Point 2

Claim 189 recites:

> iii)   if security is verified, allowing the intelligent agent to obtain information from each ATM; and
>
> iv)   causing the intelligent agent to carry the information to a site where the predictions are made.

The conditional operation of (iii) has not been shown in the references.

The carrying operation of (iv) has not been shown in the

references.

RESPONSE TO REJECTION OF CLAIM 190 AND 195 - 198

These claims were rejected as obvious, based on Gill and Kolls.

Point 1

Claim 190 states that a "list" is stored in an ATM. Kolls is cited to show this.

Kolls shows a pay-type copy machine, which accepts payment via debit cards.

Even if, somehow, a teaching is found which suggests storing the "list" of Gill in the copy machine of Kolls, the claim is not attained. What is attained is the list of Gill, but stored in a copy machine.

Claim 190 states that a "list" (of service personnel) is stored in an ATM.

Point 2

For Kolls to be relevant, as a minimum, it must be shown that

1) a teaching is present for storing the list

of Gill in Kolls and

2) Kolls is equivalent to an ATM.

As to (2), MPEP § 2144.06 states:

> In order to rely on equivalence as a rationale
> supporting an obviousness rejection, the
> equivalency must be recognized in the prior
> art, and cannot be based on . . . the mere
> fact that the components at issue are
> functional or mechanical equivalents.

Applicant points out that a copy machine is not an ATM machine, nor an equivalent.

Point 3

It makes no sense for the list of Gill to be stored in Kolls. The machines in Gill and Kolls are **completely different**. The technicians in Gill would have no idea how to service the copy machines of Kolls.

No expectation of success has been shown.

Point 4

The discussion above applies to claims 195 - 198.

RESPONSE TO REJECTION OF CLAIM 191 AND 192

These claims were rejected as obvious, based on Gill, Kolls, Slotznick, and Glowny.

Claim 191

No "intelligent agent" "carrying" a "list," "one at a time,"

as claimed, has been shown in the references.

Claim 192

Claim 192 states that, if security of the agent is verified, then the list is accepted.

As explained above, in connection with claim 184, the claimed verification is not found in Glowny.

Further, in the present case, if security is verified, the list is accepted. Such acceptance is found nowhere in Glowny.

RESPONSE TO REJECTION OF CLAIM 193 AND 194

These claims were rejected as obvious, based on Gill, Hirosawa, and Slotznick.

Claim 193

Point 1

The Office Action, page 16, last three paragraphs, gives a characterization of each of the three references. However, even if those characterizations be accepted, the claim is not found.

Claim 193 states that the "intelligent agent" is launched onto the network, and attempts to contact a service person on the list. None of the characterizations shows that.

Point 2

Two of the references teach opposite to the claimed launching of the intelligent agent.

According to the Office Action, Hirosawa and Slotznick both make some type of call to a third party to solve a problem. They do not send out an intelligent agent to solve the problem. They thus teach away from use of the intelligent agent for this purpose.

Claim 194

Point 1

Claim 194 recites a persistent intelligent agent. That has not been shown in the references.

Point 2

The Office Action invokes a supposed definition of "intelligent agent" given by Slotznick.

However, such a definition is irrelevant, unless it be shown that Slotznick's definition is accepted in the art.

. The definitions which apply are those found in Applicant's Specification, and those accepted in the art. A reference's private definition is not relevant.

RESPONSE TO ALL OBVIOUSNESS REJECTIONS

Applicant points to MPEP § 706.02(j), which is summarized in

Point 1, below. This MPEP section states:

Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to
meet the claim, it is necessary to modify a
single reference or to combine it with one or
more other references. After indicating that
the rejection is under 35 U.S.C. 103, the
examiner should set forth in the Office
action:

(A) the relevant teachings of the prior art
relied upon, preferably with reference to the
relevant column or page number(s) and line
number(s) where appropriate,

(B) the difference or differences in the claim
over the applied reference(s),

(C) the proposed modification of the applied
reference(s) necessary to arrive at the
claimed subject matter, and

(D) an explanation why one of ordinary skill
in the art at the time the invention was made
would have been motivated to make the proposed
modification.

To establish a prima facie case of
obviousness, three basic criteria must be met.

First, there must be some suggestion or
motivation, either in the references
themselves or in the knowledge generally
available to one of ordinary skill in the art,
to modify the reference or to combine
reference teachings.

Second, there must be a reasonable expectation
of success.

Finally, the prior art reference (or
references when combined) must teach or
suggest all the claim limitations.

50

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Point 1

This MPEP section states that

1) a **REASON** for modifying the references must

be given, and

2) the **MODIFICATION** must produce the claimed

invention.

To repeat: the **REASON** leads to the **MODIFICATION** which

produces the claimed invention.

The Office Action is not following this approach.

Instead, in every case, the Office Action

1) **assumes** that the combined references show

the claimed invention, and

2) justifies the combination on the grounds

that **something desirable is attained**.

For example, on page 3, references are combined for the reason

that the combination "facilitate[s] early problem detection."

The Office Action does not follow the MPEP section, because

the Office Action applies a post hoc analysis.

That is, the Office Action relies on qualities of the

references, but **after combining them**. That is, the qualities do

not exist in the **separate** references, but in the combination.

Point 2

From another perspective, the MPEP's sequence is this:

TEACHING -->> MODIFICATION -->> CLAIMED INVENTION

That is, the teaching leads to the modification/combination of references, which produces the claimed invention.

The Office Action's sequence is this:

MODIFICATION -->> DESIRED QUALITIES -- >>
TEACHING -->> MODIFICATION -->> CLAIMED INVENTION

. That is, the modification/combination of the references leads to the desired qualities. Those desired qualities are treated as the teaching for combining/modifying the references. That modification/combination supposedly produces the claimed invention.

The Office Action's approach is a <u>post hoc</u> analysis. It does not start with a teaching, as the MPEP requires.

Point 3

The Office Action's approach employs circular logic. That is, the modified references are taken as showing desirable qualities.

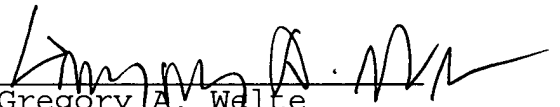Those desirable qualities are taken as a teaching for making the modification.

That is circular logic.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

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